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R E M A R K S

Claims 1-16 are pending in the instant application. Claims 2, 6, and 10 have been amended to include the features of their respective base claims. No new matter is added. It is respectfully submitted that the amendment do not raise new issues, simplify issues on appeal, and/or place the claims in condition for allowance. Therefore, it is respectfully requested that the amendments be entered. In view of the amendments and the following remarks, favorable reconsideration of this case is respectfully requested.

Applicants note with appreciation that the Examiner continues to acknowledge that claims 2-4, 6, 7, and 10 are directed to patentable subject matter. With the amendment of claims 2, 6, and 10 into independent form, it is respectfully submitted that claims 2-4, 6, 7, and 10 are in condition for allowance.

Claim 1, 5, 8, 9, and 11-16 remain rejected under 35 U.S.C. 103(a) as unpatentable over United States Patent No. 6,078,806 to Heinonen (hereinafter referred to as Heinonen) in view of United States Patent Publication No. 2003/0183691 to Lahteenmaki (hereinafter referred to as Lahteenmaki). Applicants respectfully traverse the rejection.

Claim 1 relates to a portable telephone terminal device that includes, *inter alia*, a recording medium adapted to record information of a subscriber. The portable telephone terminal device of claim 1 also includes *means for restricting execution of a service* that incurs payment, *except for a telephone call service, based on information indicative of a master-slave relation* recorded in said recording medium.

The Examiner asserts that Heinonen discloses means for restricting execution of a service that incurs payment except for a telephone call services based on information (Office Action; page 2, lines 13-15; and page 3, lines 15-17; citing Heinonen; col. 2, lines 7-16). However, the

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example provided by the Examiner relates to *information relating to restricting a telephone service*, for instance long distance calls, foreign calls, and service calls (Office Action; page 3, lines 15-17; citing Heinonen; col. 2, lines 7-16). The cited section of Heinonen states in its entirety:

The international patent application WO 91/12698 presents a mobile phone to which it is possible to add properties by means of a separate add-in card, such as a smart card. In this way it is possible to restrict the use of the phone by *preventing foreign calls, long-distance calls or calls to service numbers*, for example. The information about call restrictions is saved on an add-in card which the user has to install in the mobile phone when it is being used. Thus the main use of this method is to prevent the use of some properties of the mobile phone.

(Heinonen; col. 2, lines 7-16; emphasis added). Therefore, neither of the references discloses or suggest restricting a service except for telephone service, and therefore for at least this reason claim 1 is allowable.

Furthermore, the Office Action fails to even allege that the information restricting execution of a service is *information relating to a master/slave relationship*. In Heinonen, the information is on a separate add-in card and relates to call restrictions only, and not a master/slave relationship. The master/slave relationship discussed in Lahteenmaki relates to communication between two devices, for example between a wireless communications terminal and a smart card reader and between a smart card reader and a smart card. Lahteenmaki does not appear to disclose or suggest *means for restricting execution of a service based on information indicative of a master-slave relation*. Lahteenmaki apparently only discloses particular devices having a master or slave relationship with respect to other particular devices during communication between the devices. Lahteenmaki does not disclose or suggest that execution of a service is restricted based on an indicator of a master-slave relation. Similarly, the information

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in Heinonen also does not relate to a master/slave relationship, and also apparently restricts telephone call service, in direct contravention of the claim language relating to the restrictions. The Examiner cites three sections in Heinonen relating to master/slave relationships (Office Action; page 2, lines 3-6), however these sections apparently discuss a master control unit (MCU) controlling the operation of a mobile station using stored program code (Heinonen; col. 4, lines 23-29), and relate to an MCU being switchable into a slave state (Heinonen; col. 13, lines 12-24; and col. 14, lines 30-42). Therefore, Heinonen provides no disclosure and gives no suggestion relating to *restricting non-telephone services based on a master/slave relationship*. Applicants submit that none of the references disclose or suggest the feature of claim 1 of means for restricting execution of a service that incurs payment, except for a telephone call service, based on information indicative of a master-slave relation. Therefore, for at least this reason, claim 1 is allowable over the combination of the references.

The Examiner also maintains that the combination of the references is obvious but does not provide any proper rebuttal to Applicants' assertion that there is no motivation to combine the references (Office Action; page 2, lines 20-24). The Federal Circuit has held that there must be "findings as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed." (*In re Kotzab*, 217 F. 3d 1365, 1371 (Fed. Cir. 2000); emphasis added).

The Examiner asserts that it would have been obvious to one ordinary skilled in the art at the time of the invention to combine Lahteenmaki and Heinonen to implement use of a well known master/slave communication or relation or protocol so that an arrangement is designed to enable electronic payment of purchases made with a mobile terminal or mobile phone. However, the

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Office Action provides no indication of the *manner of combining the references*, and *does not provide any citations to either reference indicating a suggestion to combine the references*.

There is no proper motivation to combine the references and there is no suggestion in either of the references to suggest the manner of combining the disclosures. In particular, it appears that the use of the master/slave relationship as restricting execution of a service is not suggested since Heinonen does not suggest the use of this relationship to restrict execution, and Lahteenmaki apparently only suggests a master/slave relationship existing between two devices that communicate with each other. Applicants assert that the only motivation to combine the references results from the instant specification, and that this motivation results from improper hindsight reasoning. Therefore, for at least this additional reason, the rejection should be withdrawn.

Claims 5 and 9 include features similar to those discussed above in regard to claim 1, and therefore, for at least the same reasons as claim 1 is allowable, claims 5 and 9 are also allowable.

Claims 8 and 11-16 depend from one of claims 1, 5, and 9, and therefore each of these claims is allowable for at least the same reasons as their respective base claims are allowable.

Additionally, claims 11, 13, and 15 each include the feature that the master-slave relation is between the portable telephone terminal device and a second terminal device, or a similar feature. The Examiner asserts that Heinonen discloses this feature in figure 7 and at column 12, lines 8-20. However, figure 7 only shows two mobile devices communicating with each other, and gives no suggestion as to a master/slave relationship. The section cited by the Examiner states in its entirety:

FIG. 7 shows an application in which two mobile stations 1 do communicate with each other by means of the first means of data transfer IR. It is possible to transfer e.g. data and/or speech. Preferably the first means of data transfer IR makes it possible to

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connect the mobile station 1 also e.g. to a movable PC which has the corresponding means for data transfer IR or to a wireless LAN (Local Area Network).

The method of the invention provides a flexible means for increasing the usability of the mobile station 1. A mobile station 1 in accordance with the invention can make use of various services from suppliers who produce and sell applications 18. For credit card companies, a method like this is one way of reducing misuse of credit cards.

(Heinonen; col. 12, lines 8-20). As is apparent from the quoted section, *there is no indication therein relating to a master/slave relationship*. Therefore, for at least this additional reason, it is respectfully requested that the rejection of claims 11, 13, and 15 be withdrawn.

Similarly, claims 12, 14, and 16 include the feature that the portable telephone terminal device and the second terminal device do not communicate directly, or a similar feature. The Examiner asserts that Heinonen discloses this feature in figures 5 and 6. However, these figures do not show multiple telephone terminal devices, and also do not show a master/slave relationship. In fact, figure 7, as cited by the Examiner against an intermediate claim for each of these claims, shows two telephone devices communicating directly. Heinonen's only apparent disclosure of two terminal devices, in figure 7, discloses the two terminal devices communicating with each other. It is therefore respectfully submitted that Heinonen does not disclose or suggest that the portable telephone terminal device and the second terminal device do not communicate directly, as recited in the claims. Therefore, for at least this additional reason claims 12, 14, and 16 are allowable.

CONCLUSION

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider

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this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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